



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,530	04/07/1999	KENJI MASAKI	325772009100	6413

25227 7590 08/01/2002

MORRISON & FOERSTER LLP
2000 PENNSYLVANIA AVE, NW
SUITE 5500
WASHINGTON, DC 20006-1888

EXAMINER

CHOOBIN, BARRY

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 08/01/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/287,530

Applicant(s)

MASAKI, KENJI

Examiner

Barry Choobin

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. The Request for a Continued Examination filed on July 23, 2002 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: "placing information within **only** specific bit positions within only the predetermined positions..." (refer to Preliminary Amendment July 23, 2002, page 3, lines 9-10 and 21). There is nothing in Applicants claims that limits their interpretation to placing bits only where Applicants argue they ought to be placed. The claims are open ended and there is no such a limitation in the claims as Applicants now argue. Since this feature is critical to the invention its absence from the claim raises the 112 issue.

Claim Rejections - 35 USC § 102

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

II. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al (U.S. Patent 5,583,941)

As to claims 1, 6, 11, Yoshida et al disclose an image processing apparatus including:

a processor, wherein the processor places bits for describing information different from information of image data obtained by image processing on original image data (column 7, lines 23-31 and Fig. 6 wherein FIG. 6 illustrates a situation when a block data is embedded in an image, one level (say "0") of a binarized data is expressed at a density which is the same as those of adjacent pixels, while the other level ("1") is expressed at a density which is different a little from those of adjacent pixels. This data is hereinafter referred to as "density data". Further, in the example shown in FIG. 6, each density data in a block is arranged with a distance of one pixel. A block data consists of total 19 bits ($=2+7+8+2$), and it can be embedded if there is a line of a length longer than 40 dots, as shown as a central

Art Unit: 2621

horizontal dot line in FIG. 6. The 40 dots has a length of $1/10$ inch (about 2.5 mm) for a printer or an image reader of a resolution of 400 dots per inch, and black lines of such a length may exist in most documents including characters. That is, an additional data of 40 dots can be embedded sufficiently in such a document.),

[illegible]

Art Unit: 2621

respectively in specific bit positions of pixel data at predetermined positions of said processed image (Fig.6 LSB corresponds to specific bit position), each of the pixel data being expressed by using multiple bits (refer for example to column 7, lines 24 – 32 wherein a block data consists of total 19 bits ($=2+7+8+2$), and it can be embedded if there is a line of a length longer than 40 dots, as shown as a central horizontal dot line in FIG. 6. The 40 dots has a length of 1/10 inch (about 2.5 mm) for a printer or an image reader of a resolution of 400 dots per inch, and black lines of such a length may exist in most documents including characters. That is, an additional data of 40 dots can be embedded sufficiently in such a document.).

As to claims 2, 7, 12, Yoshida et al disclose pixels are dispersed at a plurality of predetermined positions on said image (column 7, lines 53-57 where block data are embedded dispersed in a hard copy).

As to claims 3, 8, 13, Yoshida et al disclose said information different from information of said processed image data is information describing the contents of image processing performed (column 10, lines 15-22 where mark registration section 408 marks such as "secret" corresponds to information describing the contents of image) on said original image data to obtain said processed image data.

As to claims 4, 9, 4, Yoshida et al disclose information different from information of said processed image data is information describing time when said image

processing is performed on original image data to obtain said processed image data (column 2, lines 27-36 where registration data determines the repetition time corresponding to "when image processing is performed").

As to claims 5,10, 15, Yoshida et al disclose information different from information for describing said processed image data is information describing time when said bits are placed (column 2, lines 27-36 where registration data determines the repetition time corresponding to "when image processing is performed").

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry Choobin whose telephone number is 703-306-5787. The examiner can normally be reached on M-F 7:30 AM to 18:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/287,530
Art Unit: 2621

Page 8

Barry choobin

July 29, 2002



LEO BOUDREAU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600